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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 08049.0929-00000							
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Application Number 10/817,574	Filed April 2, 2004								
First Named Inventor Daryl HAMILTON									
Art Unit 3627	Examiner Dana AMSDELL								

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

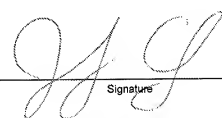
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number 61,612

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



 Signature
Judy W. Chung

 Typed or printed name
(571) 203-2700

 Telephone number
October 27, 2010

 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Daryl Hamilton)	Group Art Unit: 3627
)	
Application No.: 10/817,574)	Examiner: Dana Amsdell
)	
Filed: April 2, 2004)	
)	
For: SYSTEM AND METHOD FOR)	Confirmation No.: 3806
TRACKING OF MAIL USING A)	
UNIVERSAL CODING SYSTEM)	Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, completed form PTO/SB/33, and appeal fee payment filed concurrently herewith, Applicant respectfully requests a pre-appeal brief review of this application.

The Rejection of Claims 1-20 Under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner Fails to Establish a *Prima Facie* Case of Obviousness

The Final Office Action mailed on July 27, 2010 ("FOA"), failed to provide adequate rationales to support a conclusion of obviousness in this case because the FOA did not properly ascertain the scope and content of the cited references, and because there are significant differences between the teachings of the cited references and the claims, as a whole. M.P.E.P. § 2141 (II, III) ("The gap between the prior art and

the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'") (internal citations omitted). Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

For example, independent claim 1 recites a method of tracking a tray of items, including, among other things, "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label," and "associating [a] tray with a container, the container having a container unique identifier." As explained on page 3-5 of the Reply filed September 30, 2010 ("Reply to FOA"), the alleged combination of *Radican*, *Sansone*, and Official Notice does not render claim 1 obvious.

In the FOA and the Advisory Action mailed October 13, 2010 ("AA"), the Examiner characterized the system in *Radican* as directed to "container identification and monitoring/logistics . . . [by using] a unique label of the container," and alleged that "*Radican* discloses 'an embodiment utilizing 'enhanced' label technology for container application (column 13, lines 18-30)." (AA, p. 2, lines 4-5; FOA, p. 4, lines 5-7). However, *Radican* does not teach the enhanced label as recited in claim 1, which comprises a routing code and a label unique identifier. Specifically, as stated in the FOA, *Radican* discusses the use of a container unique identifier for monitoring containers. (See FOA, p. 4, lines 1-4). Claim 1 recites an enhanced label and a container unique identifier. In other words, the enhanced label is different from the

container unique identifier. Therefore, the container unique identifier of *Radican* is not the enhanced label as recited in claim 1.

As explained on pages 3-4 of the Reply to FOA and on page 11 of a Reply to Office Action dated May 3, 2010, the portion of *Sansone* relied upon by the FOA discloses label 29 and tag 32, which are directed to routing information, but not the recited enhanced label which comprises a routing code and a label unique identifier. In the AA, the Examiner relied upon *Sansone*'s alleged disclosure of "the trays indicating the contents of the trays," as teaching "a label unique identifier." This is incorrect. *Sansone* discloses a label 29 that includes information identifying tray contents 58, which includes the class of mail, zip code information, and degree of sortation. (*Sansone*, col. 4, lines 21-27). The label 29 of *Sansone* does not constitute the claimed label unique identifier. Accordingly, *Sansone* does not disclose or suggest "an enhanced label," as recited in claim 1.

Dependent claim 5 provides examples of the label unique identifier of claim 1. For example, claim 5 recites that the label unique identifier comprise "at least one of a machine identifier, a label source, a holdout identifier, a serial number, and a label type." *Sansone* does not teach identifiers that are related to the label or the generation of the label. Accordingly, in addition to failing to teach or suggest the claimed label unique identifier, *Sansone* does not teach or suggest claim 5.

Finally, the Examiner again improperly relied on Official Notice for "the enhanced label being unique within a predetermined time period." As explained on pages 4-5 of the Reply to FOA, the Official Notice is improper at least because the Examiner has taken Official Notice of facts not in the record, without direct reliance on a cited prior art

reference in support of this rejection. See M.P.E.P. § 2144.03. Instead of citing any prior art reference, the Examiner merely referenced “the pertinent art section of the Final Office Action, and also cited on Form 892.” Therefore, Applicant maintains that the Official Notice is improper.

For at least the foregoing reasons, the alleged combination of *Radican*, *Sansone*, and the Official Notice (which is improperly taken) cannot result in or suggest the combination of claim 1, and independent claims 7 and 13 which contain elements similar to those recited in independent claim 1. Similarly, dependent claims 2-6, 8-12, and 14-20 incorporate the elements discussed above with respect to claim 1 (as well as other novel elements), and therefore, dependent claims 2-6, 8-12, and 14-20 are also allowable. For at least the above reasons, Applicant respectfully submits that the FOA failed to establish the necessary showings under 35 U.S.C. § 103(a), and the Examiner’s 35 U.S.C. § 103(a) rejections of the claims include clear errors in ascertaining the scope of the cited art.

II. CONCLUSION

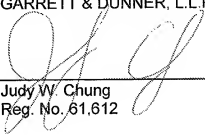
Because the Examiner’s 35 U.S.C. § 103(a) rejections of the claims include clear errors, and because the FOA failed to establish a *prima facie* case of obviousness of claims 1-20, as demonstrated herein and in the previously filed responses, Applicant is entitled to reversal of the rejections in the FOA.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 27, 2010

By: 
Judy W. Chung
Reg. No. 61,612